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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/684,869	10/06/2000	David Allison Bennett	PSTM0009/MRK/STM	2834

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EXAMINER

COSIMANO, EDWARD R

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/684,869

Applicant(s)

BENNETT ET AL.

Examiner

Edward R. Cosimano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-63 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 July 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/15/04; 11/24/04</u> . | 6) <input type="checkbox"/> Other: _____ |

1. Applicant should note the changes to patent practice and procedure:
 - A) effective December 01, 1997 as published in the Federal Register, Vol 62, No. 197, Friday October 10, 1997;
 - B) effective November 07, 2000 as published in the Federal Register, Vol 65, No. 54603, September 08, 2000; and
 - C) Amendment in revised format, Vol. 1267 of the Official Gazette published February 25, 2003.
2. Applicant's claim for the benefit of an earlier filing data under 35 U.S.C. § 119(e) is acknowledged.
3. The proposed drawing correction filed July 15, 2004 has been approved.
4. The drawings filed 15 July 2004 are objected to because:
 - A) the following errors have been noted in the drawings:
 - (1) The drawings are objected to as failing to comply with 37 CFR § 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description:
 - (a) 1071 of fig. 36a as disclosed in the paragraph 256 located at page 47, lines 21-28, "At the intersection ... element 1071 ... for which that cell represents the intersection."
 - (2) The drawings are objected to as failing to comply with 37 CFR § 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description:
 - (a) note below in section (5)(B)(1) of the objection to the disclosure.
 - (3) in regard to figs. 27B & 27C, paragraph number 197 located at page 34 of the substitute specification, "[0197] In one embodiment, once the Shipper removes the cursor from the Weight field 1051, the System stops polling the scale 622. If prior to the last polling to the scale, the scale notifies the System that the weight has stabilized 623, the System will proceed with preparing the Graphic Array if requested to do so by the Shipper 625. Otherwise, if the

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System determines a difference in weight, the System notifies the Shipper that the weight is not stable 624.”, where jump point path (B) from step 620, if the inquiry is NO (fig. 27B), to step 622 (fig. 27C) as depicted is not described.

(4) in regard to figs. 36C & 36D, paragraph number 295 located between pages 57-58 of the substitute specification, “[0295] As depicted in FIGS. 36C through 36D, for each carrier 3022, the System performs the following procedures: 1) determine if the particular carrier supports the given billing option based on step 2, 3026. If not, continue with the next carrier 3027; 2) Apply carrier business rules, including: a) Calculate dimensional weight 3023; b) Determine billable weight 30244 actual weight, dimensional weight, oversize weight or letter weight; c) Validate package weight and dimensions 3025; *(If the rate input violates carrier business rules 3026, continue to next carrier 3027)*; 3) Determine the zone ID from CarrierZone table for the given origin/destination postal codes 3028; 4) Determine service delivery times 3029 (including Saturday/Sunday delivery times) by joining the following tables on destination postal code: a) CarrierDeliveryArea; b) CarrierServiceDelTime; 5) Determine all service charges from CarrierRate table by RateID, ZoneID, ServiceID and Weight 3030; 6) Determine the service option charges for each Carrier/service 3031 by joining the following tables on CarrierID and ServiceID: ServiceOption; ServiceOptioAttribute ServiceAndServiceOption; and 7) Apply billing options to service option charges 3032 (different service option charges could be billed to different parties for various billing options).”, where the text in italic does not correspond to what is depicted in these figures.

4.1 Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining

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figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

5. The disclosure, in reference to the substitute specification filed July 15, 2004, is objected to because of the following informalities:

A) applicant must update:

(1) the application data on page 1,

with the current status of each of the referenced applications, e.g., --now abandoned--, or --now patent #?--, or --which is abandoned and now serial number #?--, --which is expired--, etc.

B) as required by 37 CFR § 1.84(p(5)) and 37 CFR § 1.121(e) the specification lacks an explicit reference to the nature of:

(1) reference legend(s):

(a) 9n, 11n, 12n, 13n, 21a, 1003a, 1003b, 1003c, 1003d, 1024n & 1027n of fig. 7 as this figure is being described in paragraphs 126-132 located on pages 18-20; and

(b) 2090 fig. 72 as this figure is described in paragraph numbers 426-449 on pages 89-95; and

(2) how the program proceeds after box(es):

(a) 620 of fig. 27B if the inquiry is "NO" in the paragraph number 197 located at page 34, note above in section 4(A)(3), where jump point path (B) from step 620, if the inquiry is NO (fig. 27B), to step 622 (fig. 27C) as depicted is not described;

(b) 3026 of figs. 36C & 36D if the inquiry is "NO" in the paragraph number 295 located at pages 57-58, note above in section

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4(A)(4), where jump point path (A) from step 3026, if the inquiry is NO (fig. 36C), to step 3028 (fig. 36D) as depicted is not described;

(c) 1163, 1168, 1169, 1172 & 1175 of fig. 39b if the inquiry is "NO" as this figure is described in paragraph numbers 313-323 on pages 62-64; and

(d) 1180, 1184, 1187 & 1190 of fig. 36c if the inquiry is "NO" as this figure is described in paragraph numbers 323-330 on pages 64-65.

In this regard, it is noted that merely mentioning either a feature or a number with out mentioning the device or operation or number or feature relies on the drawing to provide support for the disclosure and not to aid in the understanding of the invention, as is the purpose of the drawings (37 CFR § 1.81(a,b)).

C) the following errors have been noted in the specification:

(1) see the objection to figs. 27B & 27C above in section 4.

(2) see the objection to figs. 36C & 36D above in section 4.

Appropriate correction is required.

6. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(a)-1.121(f) & § 1.121(h)-1.121(i).

7. Claims 1-6, 8-27, 29-48 & 50-63 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7.1 In regard to claims 1-6, 8-27, 29-48 & 50-63, although on of ordinary skill at the time of the invention would known how to accomplish each of the individual recited actions/functions from the language of these claims, since, there is no clear and definite interconnection between one or more of the recited limitations of these claims, one of ordinary skill could not determine from the language of these claims whether or not they are in fact

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making and/or using the claimed invention. In this regard it is noted that from the language of these claims it is vague, indefinite and unclear:

A) in regard to claims 1, 22 & 43 and how the system may use “a set of package specifications” to determine the applicant shipping fee for one or more carriers, since as recited in this claim this information is not entered into the system so that it may be used to determine the appropriate shipping fees.

B) in regard to claims 2-4, 23-25 & 44-46 and how the “shipping rate for shipping the particular respective parcel according to a set of parcel characteristics shipping rules for the particular carrier, according to a set of pricing rules for each particular delivery service offered by the particular carrier, according to a set of parcel specifications for the particular respective parcel and according to an origin zip code and a destination zip code”, are used to determined the shipping rate since these claims lacks either (1) “a set of parcel characteristics shipping rules for the particular carrier” or (2) “a set of pricing rules for each particular delivery service offered by the particular carrier” or (3) “a set of parcel specifications for the particular respective parcel” or (4) “an origin zip code and a destination zip code”.

C) in regard to claims 8-14, 29-35 & 50-56, how the shipping rates for a plurality of shipping carriers may be compared, since this claim fails to require that any shipping rate for any one or more carriers be determined so that it may be compared to another carrier’s rate (claims 8, 29 & 50), or the lowest rate may be determined (claims 9, 30 & 51) and reported (claims 10, 31 & 52), or visually displayed (claims 11, 32 & 53), or audibly announced (claims 12, 14, 33, 35, 54 & 46), or displayed in order form the lowest to the highest (claims 13, 34 & 55).

E) in regard to claims 15-21, 39-42 & 57-63, how the shipping delivery schedules for a plurality of shipping carriers may be compared, since this claim fails to require that any shipping schedule for any one or more carriers be determined so that it may be compared to another carrier’s schedule (claims 15, 36 & 57), or the lowest rate may be determined (claims 16, 37 & 58) and reported (claims 17, 38 & 59), or visually

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displayed (claims 18, 39 & 60), or audibly announced (claims 19, 21, 40, 42, 61 & 63), or displayed in order form the earliest to the latest (claims 20, 41 & 62).

7.2 Claims not specifically mentioned above, inherit the defects of the base claim through dependency. For the above reason(s), applicant has failed to particularly point out what is regarded as the invention.

8. 35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

8.1 Claims 1-63 are rejected under 35 U.S.C. § 101 because the invention as claimed is directed to non-statutory subject matter.

8.1.1 The instant claims recite a system, (claims 1-21), and a method comprising a series of steps to be performed on a computer, (claims 22-42), and a manufacture comprising program code to be executed by a computer, (claims 43-63), which have a disclosed practical application in the technological or useful arts. Further, the instant claims do not merely define either a computer program, a data structure, non-functional descriptive material, (i.e. mere data) or a natural phenomenon.

8.1.2 In regard to claims 1-63, the invention as set forth in these claims merely describes:

A) in regard to claims 1-8, a client/server structured network in which the user at the client requests a series of shipping rates from plurality of carriers based on user specified information and the carrier's rating structures.

B) in regard to claims 8-21, a system that manipulates shipping related information/data into a series of audio/visual displays, where the system does not generate or obtain form an external source.

C) in regard to claims 22-28, a method using a client/server structured network in which the user at the client requests a series of shipping rates from plurality of carriers based on user specified information and the carrier's rating structures.

D) in regard to claims 29-42, a method of operating a system that manipulates shipping related information/data into a series of audio/visual displays, where the system does not generate or obtain form an external source.

E) in regard to claims 43-49, a manufacture that when implemented controls a client/server structured network in which the user at the client requests a series of shipping rates from plurality of carriers based on user specified information and the carrier's rating structures.

F) in regard to claims 50-63, a manufacture that when implemented controls the operation of a system that manipulates shipping related information/data into a series of audio/visual displays, where the system does not generate or obtain form an external source.

However, the process/system/manufacture as recited in these claims does not apply the result of either the claim as a whole or the manipulations of data as recited in these claims in such a manner so as to be tangibly used in a concrete manner and hence to produce a useful concrete and tangible result, that is a concrete and tangible application with in the technological or useful arts.

8.1.3 It is further noted that applicant has not recited in these claims a specific process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, which is either:

- A) altered or changed or modified by the invention recited in claims; or
- B) utilizes the result of the invention recited in these claims; or
- C) is operated or controlled by the result of the invention recited in these claims.

8.1.4 It is further noted in regard to claims 1-63, that as claimed applicant has not claimed:

A) pre computer processing, since the claims fail to recited that the data, which originates from an unknown source, is manipulated or transformed/changed before it is processed; or

B) post computer processing, since the claims fail to recited that the data which represents the result of the claimed manipulation, is neither manipulated nor used nor changed by any device after it has been processed; or

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C) a practical use of the claimed invention by any physical system or device or method outside of a statement of the intended use of the claimed invention; or

D) process steps or physical acts/operations that would affect the internal operation of a computer/machine as were found to be statutory in either In re McIlroy 170 USPQ 31 (CCPA, 1971) or In re Waldbaum 173 USPQ 430 (CCPA, 1972); or

E) process steps or physical acts/operations that would be considered as going beyond the manipulation of “abstract ideas” as were found to be non-statutory in In re Warmerdam 31 USPQ2d 1754 (CAFC, 1994); or

F) a concrete and tangible practical application of either:

(1) the invention as a whole; or

(2) the final results of the manipulations/actions with in the technological or useful arts;

note In re Sarkar 200 USPQ 132 (CCPA, 1978) where the process step of “constructing said obstruction within the actual open channel at the specified adjusted location indicated by the mathematical model” was held to be so tenuous connected to the remaining process steps as to not be a process with in the scope of 35 U.S.C. § 101.

Hence, the invention of claims 1-63 is merely directed to an hypothetical mental exercise that manipulates an abstract idea of generating and manipulating information regarding shipping that as claimed is never used and hence is with out a claimed concrete and tangible practical application of the abstract idea, (note In re Beauregard 35 USPQ2d 1383 (CAFC 1995) and the associated claims of U.S. Patent 5,710,578; and State Street Bank & Trust Co. v. Signature Financial Group Inc. 47 USPQ2d 1596 (CAFC 1998)).

8.1.5 It is further noted that the type/nature of either the data or the calculated numbers does not affect the operation of the claimed invention and hence are considered to be non function descriptive material, (note In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983)).

8.1.6 In practical terms, claims define nonstatutory processes if they:

A) consist solely of mathematical operations without some claimed practical application (i.e., executing a “mathematical algorithm”); or

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B) simply manipulate abstract ideas, e.g., a bid (Schrader, 22 F.3d at 293-94, 30 USPQ2d at 1458-59) or a bubble hierarchy (Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759),

without some claimed practical application of the mathematics or abstract idea.

8.1.7 In view of the above analysis claims 1-63, as a whole, are directed to an hypothetical mental exercise that merely manipulates mathematics or an abstract idea without a claimed concrete and tangible practical application of the mathematics or abstract idea, and hence are directed to non-statutory subject matter.

8.2 Claims 1-6, 8-27, 29-48 & 50-63 are rejected under 35 U.S.C. § 101 because the invention as claimed is directed to non-statutory subject matter.

8.2.1 As set forth by the Court in:

A) In re Musgrave 167 USPQ 280 at 289-290 (CCPA 1970), “We cannot agree with the Board that these claims (all the steps of which can be carried out by the disclosed apparatus) are directed to non-statutory processes merely because some or all of the steps therein can also be carried out in or with the aid of the human mind or because it may be necessary for one performing the process to think. All that is necessary, in our view, to make a sequence of operational steps a statutory “process” within 35 U.S.C. 101 is that it be in the technological arts so as to be in consonance with the Constitutional purpose to promote the progress of “useful arts.” Cons. Art. 1, sec. 8.”, {emphasis added}; and

B) In re Sarkar 100 USPQ 132 @ 136-137 (CCPA 1978), echoing the Board of Appeals stated in regard to claim 14 “14. A method of locating an obstruction in an open channel to affect flow in a predetermined manner comprising:

a) obtaining the dimensions of said obstruction which affect the parameters of flow;

b) constructing a mathematical model of at least that portion of the open channel in which said obstruction is to be located in accordance

with the method of claim 1 using those dimensions obtained in step (a) above;

c) adjusting the location of said obstruction within said mathematical model until the desired effect upon flow is obtained in said model; and thereafter

d) constructing said obstruction within the actual open channel at the specified adjusted location indicated by the mathematical model.”;

and “Concerning claims 14-39 and the significance of “post-solution activity,” like building a bridge or dam, the board concluded: While it is true that the final step in each of these claims makes reference to the mathematical result achieved by performing the prior recited steps, we consider the connection to be so tenuous that the several steps recited in each claim when considered as a whole do not constitute a proper method under the statute.”, {emphasis added}.

8.2.2 Further, it is noted in regard to claims 14-39 of Sarkar, although step (d) of claim 14 of Sarkar references the result of step (c) of claim 14 of Sarkar it is clear from the language of step (c) of claim 14 of Sarkar that multiple adjustments to the location of the obstruction are required to be made until a location with the desired effect has been determined. Hence, the reference to constructing the obstruction at the “specified adjusted location” in step (d) of claim 14 of Sarkar is vague, indefinite and unclear in regard to which one of the possible multiple adjusted locations of the obstruction that were used during step (c) of claim 14 of Sarkar would be used when constructing the obstruction as required by step (d) of Sarkar. Therefore, without a clear connection between step (d) of Sarkar and the remaining steps of claim 14 of Sarkar, the Board of Appeals and the Court held that these claims were not a process within the meaning of process as used in 35 U.S.C. § 101 and hence were directed to non statutory subject matter.

8.2.3 As can be seen from claims 1-6, 8-27 & 29-42, these claims are directed to a series of devices for performing various functions or steps/actions/functions, which as set forth above in regard to the rejection of claims 1-6, 8-27 & 29-42 under 35 U.S.C. § 112 2nd paragraph, are not clearly and definitely interconnected to one another and therefore do not provide an

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operative useful machine/system or method/process with in the meaning of machine or process as used in 35 U.S.C. § 101.

8.2.4 Further on regard to the computer useable/readable medium of claim 43-48 & 50-63, the recited limitations are not clearly and definitely interconnected to one another and a device to execute the program code/instructions on the media so as to provide a useful operative and useful manufacture with in the meaning of machine or process as used in 35 U.S.C. § 101.

8.3 Claims 1-63 are rejected under 35 U.S.C. § 101 because the invention as claimed is directed to non-statutory subject matter, since:

A) in regard to claims 1-6, 8-27, 29-48 & 50-63, these claims fail to comply with the "requirements this title, namely 35 U.S.C. § 112 2nd paragraph as set forth above.

B) in regard to claims 1-4, 7-14, 22-25, 28-35, 43-46 & 49-56, these claims fail to comply with the "requirements this title, namely 35 U.S.C. § 102 as set forth below.

C) in regard to claims 5, 6, 15-21, 26, 27, 36-42, 47, 48 & 57-63, these claims fail to comply with the "requirements this title, namely 35 U.S.C. § 103 as set forth below.

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an

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international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

9.1 Claims 1-4, 7-14, 22-25, 28-35, 43-46 & 49-56 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by either PRNewswire release from Tulsa Oklahoma (herein after TULSA) or Thiel (5,699,258).

9.2 Claims 1-4, 7-14, 22-25, 28-35, 43-46 & 49-56 are rejected under 35 U.S.C. § 102(a) as being clearly anticipated by PRNewswire release from Tempe Arizona (herein after TEMPE).

9.3 Claims 1-4, 7-14, 22-25, 28-35, 43-46 & 49-56 are rejected under 35 U.S.C. § 102(e) as being clearly anticipated by Barton (2002/0022983).

9.4 In regard to claims 1-4, 7-14, 22-25, 28-35, 43-46 & 49-56, TULSA or TEMPE or Barton ('983) discloses an internet based shipping system that comprises properly programmed server and client systems to accept rating related information from users and then return to the user from the server the shipping rate for a number of different carriers. The determined rate for each of the carriers is then provided to the user so that the user may select the carrier that

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best suites the needs of the user. Further, the TULSA system permits the user track the item being shipped.

9.4.1 In regard to claims 1-4, 7-14, 22-25, 28-35, 43-46 & 49-56, Thiel ('258) discloses a networked based shipping system that comprises properly programmed central computer/server and client shipping systems to accept rating related information from users and then return to the user from the server the shipping rate for a number of different carriers. The determined rate for each of the carriers is then provided to the user so that the user may select the carrier that best suites the needs of the user. Further, the Thiel ('258) system permits the user track the item being shipped. Further, since:

A) the internet is a communications network as is the wireless network of Thiel ('258), and

B) the claims fail to recite sufficient structure so as to distinguish a particular type of communications network,

one of ordinary skill at the time the invention would recognize the two separate types of networks as functionally equivalent. Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. Cf. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability). Common situations involving nonfunctional descriptive material are:

- a computer that differs from the prior art solely with respect to nonfunctional descriptive material that cannot alter how the machine functions (i.e., the descriptive material does not reconfigure the computer), or

- a process that differs from the prior art only with respect to nonfunctional descriptive material that cannot alter how the process steps are to be performed to achieve the utility of the invention.

9.4.2 Since the systems of either TULSA or Thiel (5,699,258) or TEMPE are internet based system, it would have been inherent to one of ordinary skill at the time the invention made that

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these systems are in fact implemented as a user at a client system accessing a remote rating server over a communications network.

9.4.3 Since the systems of either TULSA or Thiel (5,699,258) or TEMPE permit comparison of shipping rates, it would have been inherent to one of ordinary skill at the time the invention made that these systems require the same service as provided from a number of different carriers must be compared in order to make any such comparison a meaningful comparison, since one of ordinary skill would recognize that a comparison the lowest cost to latest delivery time would not produce a useful result for the user.

10. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

(c) Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

10.1 Claims 5, 6, 15-21, 26, 27, 36-42, 47, 48 & 57-63 are rejected under 35 U.S.C. § 103(a) as being unpatentable over either PRNewswire release from Tulsa Oklahoma (herein after TULSA) or Thiel (5,699,258) or PRNewswire release from Tempe Arizona (herein after TEMPE) or Barton (2002/0022983) as applied to claims 1-4, 7-14, 22-25, 28-35, 43-46 & 49-56 and further in view of an obvious modification.

10.1.1 In regard to claims 5, 6, 15-21, 26, 27, 36-42, 47, 48 & 57-63 neither TULSA nor Thiel ('258) nor TEMPE nor Barton ('983) disclose comparing the delivery times a number of carriers. However, it is respectfully noted that:

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A) the user of the systems of either TULSA or Thiel ('258) or TEMPE or Barton ('983) may be more concerned with when the package may arrive at its destination due to some time related requirements rather than spending the least amount of money to have the package shipped; and

B) most carriers offer over night or next day or two days services;

It would have been obvious to one of ordinary skill at the time the invention was made that the user of the systems of either TULSA or Thiel ('258) or TEMPE or Barton ('983) could also considered the delivery times when selecting a carrier.

11. In regard to the Information Disclosure Statement filed 24 November 2004, reference number 2 has not been considered, since it can not be found.

12. The examiner has cited prior art of interest, for example:

A) Barns-Slavin et al (5,117,364) which discloses the displaying of carrier charges one at a time in a predetermined sequence to the user.

B) Kara (6,233,568) which discloses the displaying of carrier charges to the user.

13. Response to applicant's arguments.

13.1 All rejections and objections of the previous Office action not repeated or modified and repeated here in have been over come by applicant's last response.

13.2 As per the 35 U.S.C. § 102 rejection, for the reasons given above, it is believed that the rejection is proper and has been maintained, and applicant's arguments are non persuasive.

14. The shorten statutory period of response is set to expire 3 (three) months from the mailing date of this Office action.

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15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss, can be reached on (703)-308-2702. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

15.1 The fax phone number for UNOFFICIAL/DRAFT FAXES is (703) 746-7240.

15.2 The fax phone number for OFFICIAL FAXES is (703) 872-9306.

15.3 The fax phone number for AFTER FINAL FAXES is (703) 872-9306.

01/09/05


Edward R. Cosimano
Primary Examiner A.U. 3629